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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/322,062

05/27/1999

AVINOAM RUBINSTAIN

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7590

07/13/2005

BAKER BOTTS L.L.P.
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EXAMINER

LIU, SHUWANG

ART UNIT

PAPER NUMBER

2634

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/322,062

Applicant(s)

RUBINSTAIN ET AL.

Examiner

Shuwang Liu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 05/17/05 have been fully considered but they are not persuasive. The Examiner has thoroughly reviewed Applicant's arguments but firmly believes that the rejection is reasonable.

Applicant's argument – "a first modem might only have one DSL-port to transmit a 25 MBPS data upstream signal and receive a 25 MBPS downstream signal and another modem according to the present invention might be configured to have four DSL ports to exchange data at the rate 1000MBPS ... It is submitted, for the reasons stated above, that the subject matter claimed by claims 18-28 have a well established utility."

Examiner's response – As disclosed by the applicant "one DSL-port to transmit a 25 MBPS data upstream signal and receive a 25 MBPS downstream signal, only four DSL ports transmit or receive the single 100 MBPS data stream. That is, one port, two ports, or three ports cannot transmit or receive 100 MBPS data stream as recited in claims. Furthermore, the feature of the configuration of the different modem as recited in remarks is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 18-28 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific asserted utility or a well established utility.

As well known in the art, for 100 Base-TX transmission, the transmitted signal is a four-bit nibble coming in at 25 Mbps on each of the four lines (ports) to produce a cumulative rate of 100Mbps. That is, four DSL Ethernet Ports transmit a data in range from 25 to 100 Mbps in 25 Mbps increments. If the ports are less than four, the 100 Mbps data stream cannot be transmitted. The specific asserted utility or a well established utility does not support "a data splitter adapted to split a received 100 Mbps Ethernet stream into one to four 25 Mbps data upstream signals" or "a data collection and reorganization unit coupled to said one to four DSL ports and adapted to assemble said one to four 25 Mbps downstream signals into a single 100 Mbps Ethernet data stream for transmission by said physical layer module" as recited in claims 18, 23 and 26. Note, because the claimed invention is not supported by specific asserted utility or a well established utility for the reasons set forth above, credibility cannot be asserted.

Claims 18-28 are also rejected under 35 U.S.C. 112, first paragraph (see following). Specifically, since the claimed invention is not supported by either a specific asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 18-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification does not describe that "a data splitter adapted to split a received 100 Mbps Ethernet stream into one to four 25 Mbps data upstream signals" or " a data collection and reorganization unit coupled to said one to four DSL ports and adapted to assemble said one to four 25 Mbps downstream signals into a single 100 Mbps Ethernet data stream for transmission by said physical layer module" as recited in claims 18, 23 and 26.

The specification only describe on page 16 that "....From one to up to four DSL Ethernet Port modules can be used depending on the 100BaseS configuration actually implemented. The invention supports up to four DSL Ethernet Ports for a data range from 25 to 100 Mbps in 25 Mbps increments" and "The unit 192 functions to receive the demodulated data from up to four DSL Ethernet Port modules via control/data lines 204 and assemble the one or more data stream into a signal data stream." The signal data stream as described here is not a signal 100 Mbps Ethernet data stream. The

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specification teaches if a configuration of DSL Ethernet Port modules is one port, the data transmission is 25 Mbps, if a configuration of DSL Ethernet Port modules is two ports, the data transmission is 50 Mbps, if a configuration of DSL Ethernet Port modules is three ports, the data transmission is 75 Mbps, or if a configuration of DSL Ethernet Port modules is four ports, the data transmission is 100 Mbps.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shuwang Liu whose telephone number is 571 272-3036. The examiner can normally be reached on M-F, 7:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Chin can be reached on 571 272-3056. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Shuwang Liu
Primary Examiner
Art Unit 2634

July 6, 2005